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October 24, 2005
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Gags and Games, Inc.

Serial No. 76508596

Arnold S. Weintraub of The Weintraub Group, P.L.C. for Gags and Games, Inc.

Scott M. Oslick, Trademark Examining Attorney, Law Office 108
(Andrew Lawrence, Managing Attorney).

Before Hohein, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Gags and Games, Inc. has filed an application to register on the Principal Register the mark "HALLOWEEN USA" and design, as reproduced below,



for "retail store services featuring a wide variety of general merchandise with a Halloween theme" in International Class 35.¹

¹ Ser. No. 76508596, filed on April 14, 2003, which is based on an allegation of a date of first use anywhere of December 31, 1977 and a date of first use in commerce of December 31, 1994.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its services, so resembles the mark "HALLOWEEN, U.S.A." and design, which is registered on the Supplemental Register, as reproduced below,



for "retail store services featuring a wide variety of general merchandise with a Halloween theme" in International Class 35,² as to be likely to cause confusion, or to cause mistake, or to deceive. Registration has also been finally refused, under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant's failure to comply with the requirement for a disclaimer of the words "HALLOWEEN USA," which the Examining Attorney contends are, respectively, merely descriptive and primarily geographically descriptive of applicant's services within the meaning of Sections 2(e)(1) and 2(e)(2) of the Trademark Act, 15 U.S.C. §§1052(e)(1) and 1052(e)(2), and therefore must be disclaimed apart from the mark as shown. In addition, registration has been finally refused, under Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), on the basis that the mark shown on the substitute drawing is not a substantially exact representation of the mark shown on the specimen of use and, thus, applicant must submit either another drawing which

² Reg. No. 2,740,841, issued on July 22, 2003, which sets forth a date of first use anywhere of August 1, 1999 and a date of first use in commerce of December 1, 2001; the word "HALLOWEEN" is disclaimed.

agrees with the mark shown on the specimen of use or submit a properly verified substitute specimen of use of the mark which is shown on the present drawing.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusals to register with respect to the ground of likelihood of confusion and as to the requirement for a disclaimer, but reverse the refusal to register on the basis that the mark shown on the substitute drawing is not a substantially exact representation of the mark shown on the specimen of use.

Turning first to the refusal under Section 2(d), our determination thereof is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the services or goods at issue and the similarity or dissimilarity of the respective marks in their entireties.³ Here, as identified, inasmuch as applicant's and registrant's "retail store services featuring a wide variety of general merchandise with a Halloween theme" are identical and thus would necessarily be rendered through the same channels of

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the [services or] goods and differences in the marks." 192 USPQ at 29.

trade to the same classes of customers, the focus of our inquiry is accordingly on the similarity or dissimilarity of the respective marks.

Turning, therefore, to such an inquiry, applicant in its brief asserts that, in essence, registrant's "HALLOWEEN, USA" and design mark "is the words, per se." Noting, moreover, the "inherent weakness" in such mark since it is registered on the Supplemental Register, and observing that the word "HALLOWEEN" is disclaimed, applicant argues that it is clear that "the registrant does not have exclusive rights in and to this word, apart from the mark as shown" and that the scope of protection to which registrant's mark is entitled does not extent to precluding registration of applicant's mark. In particular, applicant admits that "[w]hile the [respective] marks may appear to be virtually identical in sound," it insists that "most certainly they do not resemble each other in sight, and this should dissuade from any propriety of [finding that a] likelihood of confusion" exists. Applicant maintains, in this regard, that:

Contrasted with the [mark of the cited] Registration is Applicant's stylized version of "HALLOWEEN USA" which incorporates a fanciful characterization of the word "HALLOWEEN" along with a pumpkin simulating the letter "O." A pentastar surrounds [both sides of] the "USA" portion of the mark, with this part of the mark being disposed beneath the [word] "HALLOWEEN." Visually, the marks are distinct.

Applicant therefore concludes that confusion is not likely inasmuch as a "side by side comparison of the two marks shows that they are easily distinguishable from each other."

We observe, however, that a side-by-side comparison of the respective marks is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the marks. Instead, it is the similarity of the general commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

When the marks at issue are so viewed, we agree with the Examining Attorney that they are so substantially similar overall that their contemporaneous use by applicant and registrant in connection with "retail store services featuring a wide variety of general merchandise with a Halloween theme" is likely to cause confusion as to the origin or affiliation of their respective services. As the Examining Attorney accurately points out in his brief, the marks at issue "are identical in sound and meaning." While, as the Examining Attorney acknowledges, such marks differ in appearance in that applicant's mark, unlike registrant's mark, contains both a pumpkin (or jack-o'-lantern) design as well as two stars, those design features

are insufficient to preclude a likelihood of confusion. Clearly, a commonplace design such as a pumpkin (or jack-o'-lantern) for a retail store which sells Halloween-themed merchandise,⁴ and utilizing stars (which on the flag of the United States of America are widely known to represent states) to bracket the geographical term "USA" can scarcely be said to distinguish applicant's "HALLOWEEN USA" and design mark from registrant's "HALLOWEEN, U.S.A." and design mark. Moreover, as the Examining Attorney persuasively contends, it is settled that where, as is the case herein, a mark consists of a word portion and a design portion, it is the word portion which is more likely to be impressed upon a purchaser's memory and to be used in calling for or inquiring about the associated services. See, e.g., In re Dakin's Miniatures Inc., 59 USPQ2d 1593, 1596 (TTAB 1999); and In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987). Accordingly, the differences in the respective marks in appearance simply do not outweigh the identity which they share in sound and meaning.

Furthermore, as the Examining Attorney correctly points out with respect to applicant's argument that a finding of

⁴ We judicially notice, for example, that The American Heritage Dictionary of the English Language (4th ed. 2000) defines "jack-o'-lantern" at 933 as a noun connoting "[a] lantern made from a hollowed pumpkin with a carved face, usually displayed on Halloween." It is settled that, in general, the Board may properly take judicial notice of dictionary definitions. See, e.g., Hancock v. American Steel & Wire Co. of New Jersey, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852, 860 n. 7 (TTAB 1981).

likelihood of confusion is not warranted because the registrant's mark is registered on the Supplemental Register:

While it is true that the Supplemental Register does not afford registrants the full benefits accorded to registrants on the Principal Register, marks on the Supplemental Register are protected under Section 2(d) of the Trademark Act against registration of confusingly similar marks. See *In re Amtel Inc.*, 189 USPQ 58 (TTAB 1976). Similarly, although the Applicant argues that Registrant's mark is "inherent[ly]" weak, even weak marks are entitled to protection. *In re Clorox Co.*, 578 F.2d 305[, 198 USPQ 337 (CCPA 1978)]

In particular, we note with respect thereto that, as stated by the court in *In re Clorox Co.*, id. at 341, there is no "requirement that citation of marks on the Supplemental Register under §2(d) be limited to marks identical to that sought to be registered"; instead, as the court further observed:

No reason exists ... for the application of different standards to registrations cited under §2(d). The level of descriptiveness of a cited mark may influence the conclusion that confusion is likely or unlikely, see *Sure-Fit Products Co. v. Saltzon Drapery Co.*, ... 254 F.2d 158, 160, 117 USPQ 295, 297 (1958), but that fact does not preclude citation under §2(d) of marks on the Supplemental Register.

Id.

Consequently, notwithstanding what applicant characterizes as the "inherent weakness" in registrant's "HALLOWEEN, U.S.A." and design mark due to its registration on the Supplemental Register as well as the disclaimer of the word "HALLOWEEN," it is still the case that applicant's "HALLOWEEN USA" and design mark is likely to cause confusion. Such marks, as stated previously, are identical in sound and meaning, as

argued by the Examining Attorney, and the differences in appearance are insufficient to distinguish the marks, given the identity of the retail, Halloween-themed general merchandise store services in connection with which the marks are used.

Turning next to the requirement for a disclaimer of the words "HALLOWEEN USA," we note that while applicant's brief is silent with respect thereto, applicant has admitted in a response to an Office action that "the cited registration provides a disclaimer for the word 'HALLOWEEN,' for which Registrant has no exclusive rights apart from the mark as shown," and that "the 'USA' portion of the mark is primarily geographic in nature." Inasmuch as applicant's "HALLOWEEN USA" and design mark, like registrant's "HALLOWEEN, U.S.A." and design mark, is for the same services, namely, "retail store services featuring a wide variety of general merchandise with a Halloween theme," it is clear that, as argued by the Examining Attorney, applicant has conceded that the word "HALLOWEEN" is merely descriptive of its services and that the term "USA" is primarily geographically descriptive of such services.

In particular, as the Examining Attorney correctly contends in his brief:

A ... [word] is merely descriptive under Trademark Act Section 2(e)(1) ... if it [immediately, without speculation or conjecture,] describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods and/or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979) A term

is primarily geographically descriptive if the primary significance of the term is geographic and an applicant's [goods and/or] services come from the geographical place identified by the term. *In re California Pizza Kitchen [Inc.]*, 10 USPQ2d 1704 (TTAB ... [1988), citing *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 3 USPQ2d 1450 (Fed. Cir. 1987)]; *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982). Applicant's must disclaim merely descriptive and primarily geographically descriptive terms. Trademark Act Section 6 ...; TMEP sections 1213 and ... [1213.03(a) (4th ed. 2005)].

Here, as the Examining Attorney properly points out, "[t]he term HALLOWEEN in Applicant's mark is merely descriptive because it immediately identifies a feature of Applicant's services," which involve the retail sale of "a wide variety of general merchandise **with a Halloween theme**" (emphasis in original). Similarly, the Examining Attorney accurately observes that, in applicant's mark, "[t]he term USA is primarily geographically descriptive of Applicant's services because it immediately identifies the geographic location in which the services are provided, namely, the United States of America."⁵ Inasmuch as we find, in view

⁵ The Examining Attorney, in his brief, has requested that we take judicial notice that the Merriam-Webster Online dictionary defines "Halloween" as a noun meaning "October 31 observed especially with dressing up in disguise, trick-or-treating, and displaying jack-o'-lanterns during the evening" and sets forth "USA" in relevant part as an abbreviation for "United States of America." While, as indicated previously in footnote 4, it is settled that in general the Board may properly take judicial notice of dictionary definitions, in the case of on-line dictionary evidence submitted for the first time with the Examining Attorney's brief, the Board in *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999), stated with respect thereto that, "when Examining Attorneys intend to rely on Internet evidence that otherwise would normally be subject to judicial notice (such as dictionary definitions), such evidence must be submitted prior to appeal." In view thereof, the Examining Attorney's request that we take judicial notice of on-line dictionary definitions is denied. Nonetheless, we judicially notice, for instance, that The American Heritage Dictionary of the English Language (4th ed. 2000) defines

thereof and in light of applicant's admission, that the terms "HALLOWEEN" and "USA" in applicant's mark respectively are merely descriptive and primarily geographically descriptive of applicant's services, the requirement for a disclaimer of the words "HALLOWEEN USA" is proper. Section 6(a) of the Trademark Act.

This brings us to the remaining basis for refusal. We note initially that applicant, as was the case with respect to the required disclaimer, has not set forth any argument in its brief concerning the Examining Attorney's position that the mark shown on the substitute drawing does not comport with the mark shown on the specimen of record. In this regard, as stated by the Examining Attorney in his brief, it is required that when registration is sought on the basis of use in commerce, "[t]he mark shown on the drawing page of a trademark application must [substantially] agree with the mark shown on the specimen of use in that application." See Section 1(a) of the Trademark Act; Trademark Rule 2.51(a)(1), which specifically provides that "[i]n an application under section 1(a) of the Act, the drawing of the mark must be a substantially exact representation of the mark as used on or in connection with the goods and/or services"; and TMEP Sections 807.12 and 807.12(a) (4th ed. 2005). In this instance, however, the Examining Attorney maintains that while "[a]pplicant has submitted a substitute drawing in which the

"Halloween" at 792 as a noun meaning "October 31, celebrated in the United States ... by children going door to door while wearing costumes and begging treats and playing pranks" and lists "USA" in relevant part at 1894 as an abbreviation for "United States of America."

elements agree with the elements shown on the specimen, and in which the wording USA, with a star to each side, appears below the word HALLOWEEN," it is nonetheless the case that:

[T]he mark shown in the drawing still does not agree with the mark shown on the specimen because the spatial relationship between the words HALLOWEEN and USA differs on the drawing and the specimen. Specifically, in the specimen, the word USA and the two stars appear immediately below the word HALLOWEEN. However, the drawing contains a significant space in between these two elements. Accordingly, the mark shown in the drawing differs from the mark shown in the specimen of use.

We disagree with the Examining Attorney's requirement because we find that the mark shown on the substitute drawing is a substantially exact representation of the mark shown on the specimen of use. We see nothing which is "significant" in the space, as it appears on the substitute drawing of applicant's mark, which vertically separates the words "HALLOWEEN" and "USA" (as flanked by two stars). Such gap is not so wide or otherwise prominent that it alters in any meaningful way the overall commercial impression created by the mark as it appears on the specimen of use, which appears to be a photograph of the signage used over the entrance to applicant's retail store(s). In each instance, the word "HALLOWEEN" is positioned immediately above the word "USA" and its associated two stars. To even notice the difference in spacing between such elements requires exceedingly close attention to detail. The difference is simply so minor that it cannot reasonably be said that the mark as depicted on the substitute drawing is not a substantially exact

representation of the mark as actually used on the specimen. Accordingly, applicant need not comply with the requirement by the Examining Attorney that it either "submit a[nother] drawing in which the mark agrees with the mark shown on the specimen, or submit a specimen on which the mark agrees with the mark shown in the [present] drawing."

Decision: The refusal under Section 1(a) that the mark shown on the substitute drawing is not a substantially exact representation of the mark shown on the specimen of use is reversed, but the likelihood of confusion refusal under Section 2(d) and the requirement for a disclaimer under Section 6(a) are affirmed.